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**OFFICE OF PETITIONS
AND PATENTS**

In re Patent No. 4,611,581
Issue Date: September 16, 1986
Application No. 06/562,438
Filed: December 16, 1983
Inventor: Arthur D. Steffee

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ON PETITION

This is a decision on the petition filed November 17, 1995,¹ requesting that the Patent and Trademark Office (PTO) strike the statutory disclaimer filed on February 10, 1995 in the above-identified patent.

The petition is **DENIED**.

BACKGROUND

Application No. 06/562,438 was filed on December 16, 1983 with a declaration under 37 CFR 1.63 naming Authur D. Steffee (Steffee) as the sole inventor. Application No. 06/562,438 issued as U.S. Patent No. 4,611,581 on September 16, 1986.

PTO assignment records indicate that Steffee assigned the above-identified patent to Acromed Corporation Cleveland (Acromed) on November 3, 1983, and that this assignment was recorded in the PTO on December 16, 1983. PTO assignment records further indicate that: (1) Acromed entered into a license agreement concerning the above-identified patent with Danek Medical, Inc. (Danek) on March 29, 1989, and that this license agreement was recorded in the PTO on July 17, 1995, (2) Acromed assigned a security interest in the above-identified patent to Society National Bank on July 2, 1991, and that this security interest

¹ The first page of the petition filed November 17, 1995 (and facsimile cover sheet) were also submitted by facsimile on December 20, 1995.

was recorded in the PTO on January 27, 1992, and (3) Frank S. Janson (Janson) assigned the above-identified patent to Danek on January 27, 1995, and that this assignment was recorded in the PTO on July 17, 1995.²

A statutory disclaimer was filed on February 10, 1995 in the above-identified patent. The statutory disclaimer of February 10, 1995 was executed in compliance with 37 CFR 3.73(b) by Caroline Lutz (Lutz) on behalf of Acromed and by Thomas L. Tarolli (Tarolli), an attorney of record, and disclaimed claim 8 of the above-identified patent.

On November 17, 1995, Danek filed the instant petition requesting that the PTO strike the statutory disclaimer filed on February 10, 1995 in the above-identified patent. Danek asserts that Janson, rather than Steffee, is the inventor of claim 8 of the above-identified patent. Danek submits in support of its petition: (1) a copy of U.S. Patent No. 4,611,581, (2) a copy of the disclaimer filed on February 10, 1995, (3) a copy of U.S. Patent No. 4,696,290, (4) a copy of a deposition of Janson dated October 20, 1994, (5) a copy of an unexecuted declaration under 37 CFR 1.63 proffered to Janson for his signature to add Janson as a joint inventor in U.S. Patent No. 4,696,290, (6) a copy of a deposition of Steffee dated November 18, 1994, and (7) a copy of patent license and conditional sales agreement between Janson and Danek.

On February 29, 1996, Acromed filed a response to the Danek petition of February 10, 1995. Acromed submits in support of its petition: (1) a copy of an employee agreement between Janson and Acromed, (2) a copy of the PTO *Official Gazette* at 1175 *Off. Gaz. Pat. Office* 41 (June 13, 1995), in which the notice of the disclaimer filed on February 10, 1995 in the above-identified patent was published, and (3) copies of correspondence dated June 15, 1995 and June 22, 1995 between Daniel J. Lueders of Woodard, Emhardt, Naughton, Moriarty & McNett and Calvin P. Griffith of

² The recording of an document by the Office is not a determination of the validity of the document as an assignment, or the effect that such document has on the title to the application or patent. See 37 CFR 3.54. The Office acts only in a ministerial capacity with respect to documents submitted for recordation. See MPEP 317.03. The assignment by Janson to Danek of January 27, 1995 (and recorded in the PTO on July 17, 1995) is not in the chain of title to the above-identified patent, and, as such, is best characterized as a "wild" assignment. See BLACK'S LAW DICTIONARY 415 (6th Ed. 1990) (definition of "wild deed").

Jones, Day, Reavis & Pogue concerning the disclaimer filed on February 10, 1995 in the above-identified patent.

STATUTE, REGULATION AND EXAMINING PROCEDURE³

35 U.S.C. § 253 states that:

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. § 256 states that:

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all interested parties concerned and the Commissioner shall issue a certificate accordingly.

³ As set forth in the Manual of Patent Examining Procedure (MPEP).

37 CFR 1.321(a) states that:

A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) be signed by the patentee, or an attorney or agent of record;
- (2) identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term, will be refused recordation;
- (3) state the present extent of patentee's ownership interest in the patent; and
- (4) be accompanied by the fee set forth in § 1.20(d).

MPEP 1490 states, in part, that:

A disclaimer is a statement filed by an owner (in part or in entirety) of a patent or of a patent to be granted, in which said owner relinquishes certain legal rights to the patent. There are two types of disclaimers: statutory and terminal. For a disclaimer to be accepted, it must be signed by the proper party as follows:

1. A disclaimer filed in a patent or a reexamination proceeding must be signed by either (a) the patentee, or (b) an attorney or agent of record.

2. A disclaimer filed in an application must be signed by either (a) the applicant where the application has not been assigned, the applicant and the assignee where each owns a part interest in the application, the assignee where assignee owns the entire interest in the application, or (b) an attorney or agent of record.

3. Where the assignee signs the disclaimer, there is a requirement to comply with 37 CFR 3.73 (b) in order to satisfy 37 CFR 1.321. See MPEP 324 as to compliance with 37 CFR 3.73 (b). A copy of the "Certificate Under 37 CFR 3.73 (b)" reproduced in MPEP 324 may be sent by the examiner to applicant to provide an acceptable way to comply with the requirements of 37 CFR 3.73 (b).

Where the attorney or agent of record signs the disclaimer, there is no need to comply with 37 CFR 3.73 (b).

STATUTORY DISCLAIMERS

Under 37 CFR 1.321(a) the owner of a patent may disclaim a complete claim or claims of his patent. This may result from a lawsuit or because he has reason to believe that the claim or claims are too broad or otherwise invalid. If the patent is involved in an interference, see MPEP 2362.

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PROCESSING

The Certificates of Corrections Branch is responsible for the handling of all statutory disclaimers filed under the first paragraph of 35 U.S.C. § 253, whether the case is pending or patented, and all terminal disclaimers (filed under the second paragraph of 35 U.S.C. § 253) except for those filed in an application pending in an Examining Group. This involves:

1. Determining compliance with 35 U.S.C. § 253 and 37 CFR 1.321 and 3.73;
2. Notifying applicant or patentee when the disclaimer is informal and thus not acceptable;
3. Recording the disclaimers; and
4. Providing the disclaimer data for printing.

OPINION

Danek asserts that Janson, as the inventor of claim 8, owns an equitable interest in the above-identified patent, citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989), in support of the contention that a true inventor owns an equitable interest in a patent. Danek thus argues that the disclaimer filed on February 10, 1995 is improper as Acromed: (1) cannot completely disclaim claim 8 due to Janson's equitable interest in the above-identified patent, and (2) has knowingly misstated its interest in the above-identified patent. Danek further argues that the disclaimer misidentifies the patentee as Steffee, rather than Acromed, as Steffee, having assigned his interest to Acromed, has no interest in the above-identified patent. Danek further argues that Acromed's disclaimer is an attempt to correct the inventorship in the

above-identified patent while avoiding evidence requirements (e.g., "without deceptive intent") in 35 U.S.C. §§ 251 or 256.

Danek's request that the PTO strike the statutory disclaimer filed on February 10, 1995 in the above-identified patent will not be granted because: (1) Danek has no standing to complain of PTO actions concerning the above-identified patent, (2) Danek's petition of November 17, 1995 is untimely (37 CFR 1.181(f)), (3) the PTO did not err in recording the statutory disclaimer filed on February 10, 1995 in the above-identified patent, and (4) the PTO will not, pursuant to 37 CFR 1.182 or 1.183, withdraw or otherwise nullify the effect of a disclaimer properly recorded in an issued patent.

Danek lacks standing to complain of PTO actions concerning the above-identified patent:

A patentee, an assignee of record, or a registered practitioner representing a patentee or assignee of record may take action in a patent. Danek or Janson, however, do not have standing as patentee or assignee of record in the above-identified patent, and, as such, their representatives do not represent a patentee or assignee of record. Thus, Danek lacks standing to challenge the PTO's recording of the statutory disclaimer filed on February 10, 1995 in the above-identified patent. See Boeing Co. v. Commissioner of Patents and Trademarks, 853 F.2d 878, 7 USPQ2d 1487 (Fed. Cir. 1988) (a mere assertion of a right to have the PTO act in accordance with the statutes and regulations does not confer standing on a party).

Danek's petition of November 17, 1995 is untimely:

37 CFR 1.181(f) provides, in part, that "[e]xcept as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely." The notice of the disclaimer filed on February 10, 1995 in the above-identified patent was published in the PTO *Official Gazette* on June 13, 1995; however, Danek did not file the instant petition until November 17, 1995. Danek provides no explanation, much less a satisfactory explanation, as to why Danek waited five months prior to filing its petition to strike the statutory disclaimer filed on February 10, 1995 in the above-identified patent.

In addition, Danek's request does not involve an *ex parte* proceeding in a pending application, which proceedings are preserved in confidence (35 U.S.C. § 122) until a patent is granted. Rather, Danek requests that the PTO nullify Acromed's dedication and disclaimer of claim 8 of the above-identified

patent to the public, and this statutory disclaimer was published in the PTO *Official Gazette*.

The above provision of 37 CFR 1.181(f) is discretionary, rather than mandatory. Dismissal of Danek's petition under 37 CFR 1.181(f), however, is appropriate: (1) as Danek has provided no explanation as to the delay of five months in filing its petition, and (2) due to the potential for reliance by the public on the statutory disclaimer filed on February 10, 1995 in the above-identified patent via its publication on June 13, 1995 in the PTO *Official Gazette*.

The PTO did not err in recording the statutory disclaimer filed on February 10, 1995 in the above-identified patent:

It is well settled that the PTO is not the appropriate forum for resolving a dispute concerning inventorship in an application. See MPEP 201.03 ("[a]s 37 CFR 1.48(a) is intended as a simple procedural remedy and does not represent a substantive determination as to inventorship, issues relating to the inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for considerations in determining whether the record unequivocally supports the correction sought"). Put simply, the PTO will not engage in an *inter partes* proceeding (other than an interference under 35 U.S.C. § 135) to determine whether Janson or Steffee is the inventor of claim 8 of the above-identified patent. See In re Cooper, 230 USPQ 638, 639 (Comm'r Pat. 1985).

It is also well settled that the PTO is not the appropriate forum for resolving a dispute concerning the ownership of an application or patent. See, Ex parte Harrison, 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1924); In re Moller, 1904 Dec. Comm'r Pat. 70, 71 (Comm'r Pat. 1904); Ex parte McTammany, 1900 Dec. Comm'r Pat. 168, 171 (Comm'r Pat. 1900); Ex parte McFarlane, 1896 Dec. Comm'r Pat. 37, 38 (Comm'r Pat. 1896); Ex parte Gallatin, 1892 Dec. Comm'r Pat. 106 (Comm'r Pat. 1892). Thus, the PTO will

not determine whether Janson has an "equitable" interest in the above-identified patent or claim 8 of the above-identified patent.⁴

35 U.S.C. § 256 provides for correction of the inventorship in an issued patent: (1) by the PTO "on application of all the parties and assignees," and (2) by the "court before which such matter is called in question" in other instances. The statutory scheme of 35 U.S.C. § 256 provides a clear demarcation between instances when there is no dispute among "all of the parties and assignees" in which the PTO is authorized to change or correct the inventorship in an issued patent, and instances when there is any dispute among any of the parties in which the PTO is not authorized to change or correct the inventorship in an issued patent and the courts are the appropriate forum.

In this instance, there is obviously a dispute as to who is/are the inventor(s) in the above-identified patent. It would be contrary to the statutory scheme in 35 U.S.C. § 256 for the PTO to attempt to resolve this dispute. Thus, the PTO will not evaluate the evidence submitted by Danek and determine whether Steffee or Janson is the inventor of claim 8 of the above-identified patent.

The PTO cannot settle disputes as to title, or convert whatever equitable title that might exist by virtue of actual inventorship, employment or the execution of other ancillary documents. The courts are the appropriate forum to resolve the controversy at issue.

The declaration under 37 CFR 1.63 deposited with the application for the above-identified patent names Steffee as the sole inventor in the application for the above-identified patent. In the absence of a change or correction of this named inventorship, either by petition of all of the parties or judicial determination (35 U.S.C. § 256 and 37 CFR 1.324), Steffee is the sole inventor of all of the claims in the above-identified patent

⁴ While in Richardson, the Court of Appeals for the Federal Circuit determined that Richardson, as the true inventor, had an equitable interest in the patent at issue, Richardson hardly stands for the proposition that the PTO is expected, or even authorized, to determine "equitable" ownership of issued patents. Unless Janson is judicially determined to be an inventor or to have an "equitable" interest in the above-identified patent, the PTO will treat the inventorship and ownership of the above-identified patent in accordance with the inventorship and assignment indicated in PTO records.

insofar as the PTO is concerned. Thus, Steffee is the sole starting point for determining the ownership of the above-identified patent. See University Patents Inc. v. Kligman, 762 F.Supp 1212, 1218-19, 20 USPQ 1401, 1405 (E.D. Pa. 1991). Steffee assigned all of his rights and interest in the above-identified patent to Acromed on November 3, 1983, and an assignment of the entire right and interest passes both legal and equitable title. See, Wende v. Horine, 191 F. 620, 621 (C.C.N.D. Ill. 1911).

In any event, the requirement in 35 U.S.C. § 253 and 37 CFR 1.321 concerning the disclaimer of "any complete claim" does not concern the ownership of the claim, but prohibits "disclaimers" that simply further limit, rather than completely disclaim, the claim at issue.⁵ The statutory disclaimer filed on February 10, 1995 does not purport to disclaim claim 8, but simply add a further limitation to this claim. Thus, regardless of the ownership of claim 8, or any claim, in the above-identified patent, the statutory disclaimer filed on February 10, 1995 disclaims a "complete claim" 8 within the meaning of 35 U.S.C. § 253 and 37 CFR 1.321.

The issue, insofar as the PTO is concerned, is whether the PTO acted properly in recording the statutory disclaimer filed on February 10, 1995 in the above-identified patent. The statutory disclaimer submitted on February 10, 1995 is: (1) in writing, (2) disclaims complete claim 8 of the above-identified patent, (3) states that Acromed is the assignee of the above-identified patent, (4) is signed by Tarolli (an attorney of record), and (5) accompanied by the fee set forth in 37 CFR 1.20(d). As the statutory disclaimer filed on February 10, 1995 in the above-identified patent is in compliance with 35 U.S.C. § 253 and 37 CFR 1.321, the PTO did not err in recording and publishing this disclaimer.

Whether Acromed's statements in the statutory disclaimer filed on February 10, 1995 are "knowingly false" is immaterial to the propriety of the PTO's recording of this statutory disclaimer.

⁵ For example, prior to the addition of this requirement in the disclaimer statute, a patentee could disclaim "claim 13, except wherein a flywheel is operatively connected with the film through means which imparts uniformity of motion of the flywheel to the film. See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 489, 24 USPQ 308, 314 (1935). Such a "disclaimer," however, is not a disclaimer of a "complete claim" within the meaning of 35 U.S.C. § 253 and 37 CFR 1.321, since the "disclaimer" simply further limits the claim at issue.

Acromed has made the necessary statements in the statutory disclaimer filed on February 10, 1995, and the PTO is not the appropriate forum to evaluate the veracity of such statements.⁶

Danek's argument concerning the misidentification of the patentee as Steffee, rather than Acromed, is without merit. 35 U.S.C. § 101(d) does provide that "[t]he word patentee includes not only the patentee to whom the patent was issued but also the successors in title to the patent." The PTO, however, identifies the inventor(s) as the applicant(s) in an application, as well as the patentee(s) in any patent granted on such application.⁷ Thus, the PTO cannot view Acromed's identification of Steffee as the patentee and Acromed as the assignee of the above-identified patent as "misidentification." In any event, 35 U.S.C. § 101(d) does not exclude the original applicant from its definition of "patentee," and the statutory disclaimer filed on February 10, 1995 is executed both by Lutz on behalf of Acromed in compliance with 37 CFR 3.73(b) and Tarolli, an attorney of record.

Danek's argument that Acromed's disclaimer is an attempt to correct the inventorship in the above-identified patent while avoiding evidence requirements (e.g., "without deceptive intent") in 35 U.S.C. §§ 251 or 256 is of no moment. As the inventorship in the above-identified patent has not been changed or corrected pursuant to 35 U.S.C. § 256 and 37 CFR 1.324, either by petition of all of the parties or judicial determination, to name Janson as an inventor in the above-identified patent, the PTO has no authority to treat Janson as an inventor of any claim (or claim 8) in the above-identified patent, and refuse to record the

⁶ It is well established that the PTO no longer determines issues of inequitable conduct. See 1095 *Off. Gaz. Pat. Office* 16 (October 11, 1988). Thus, whether Acromed's statements are "knowingly misleading," "knowingly false," or constitute "fraud" are matters that the PTO will not determine.

⁷ For example, 37 CFR 1.377(c) provides that a petition under 37 CFR 1.377 must be signed by a registered practitioner, "or by the patentee, the assignee, or other party in interest," which indicates that the PTO does not consider an assignee to be the patentee. In addition, the party in interest during a reexamination proceeding is the patent owner (e.g., assignee), not the patentee. See 37 CFR 1.510 *et seq.* This designation of the party in interest during a reexamination proceeding as the patent owner rather than the patentee finds support in the reexamination statutes, notwithstanding that 35 U.S.C. § 101(d) defines patentee as including successors in title to the patent. See 35 U.S.C. § 302 *et seq.*

statutory disclaimer filed on February 10, 1995 in the above-identified patent. In any event, 35 U.S.C. § 253 and 37 CFR 1.321 contain no requirements relevant to, and thus do not require the PTO to evaluate, the motives of a person filing a statutory or terminal disclaimer in an issued patent.

The PTO will not, pursuant to 37 CFR 1.182 or 1.183, withdraw or otherwise nullify the effect of a disclaimer properly recorded in an issued patent:

The Supreme Court has stated that, as a general principle, public policy does not favor the restoration to a patent of that which has been dedicated to the public by disclaimer. See Altoona Publix Theatres, 294 U.S. at 492, 24 USPQ at 315; see also Leggett v. Avery, 101 U.S. (11 Otto) 256, 259-60 (1879). Thus, the PTO will not, pursuant to 37 CFR 1.182 or 1.183, withdraw or otherwise nullify the effect of a disclaimer properly recorded in an issued patent. See MPEP 1490.

As discussed *supra*, the statutory disclaimer filed on February 10, 1995 in the above-identified patent is in compliance with 35 U.S.C. § 253 and 37 CFR 1.321, and, as such, the PTO did not err in recording and publishing this disclaimer. Accordingly, the PTO will not, pursuant to 37 CFR 1.182 (or 1.183), withdraw or otherwise nullify the effect of the statutory disclaimer filed on February 10, 1995 in the above-identified patent.

CONCLUSION

For the above-stated reasons, the petition of November 17, 1995 requesting that the PTO strike the statutory disclaimer filed on February 10, 1995 in the above-identified patent is **denied**.

Telephone inquiries regarding this decision should be directed to Robert Bahr at (703) 305-9285.

This patent file is being returned to Files Repository.



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